

REMARKS

Applicants have amended the Abstract, and claims 37, 54, and 72, to overcome an objection, improve clarity, and to overcome a § 101 rejection, respectively. Upon entry of this Amendment, claims 37-72 are pending and under examination.

Regarding the Office Action

Applicants respectfully traverse the following actions:

- (a) objection to the Abstract;
- (b) rejection of claims 37-51 and 72 under 35 U.S.C. § 101;
- (c) rejection of claims 37-39, 46-51, 54-56, 63-68, 71, and 72 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,878,231 (“Baehr”); and
- (d) rejection of claims 40-45, 52, 53, 57-62, 69, and 70 under 35 U.S.C. § 103(a) as being unpatentable over Baehr in view of U.S. Patent No. 7,331,061 (“Ramsey”).

Objection to the Abstract:

In response to the objection, Applicants have amended the Abstract to reduce the number of words below 150. Accordingly, Applicants request withdrawal of the objection.

Rejection of Claims 37-51 and 72 under 35 U.S.C. § 101:

The Office Action rejected claims 37-51 and 72 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. *See* Office Action, pp. 3-4. The Office Action stated that in view of *In re Bilski*, “a statutory ‘process’ under 35 U.S.C. [§] 101 must (1) be tied to [a] particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing.” Office Action, p. 3. The Office Action alleges that the “instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter.” *Id.* The Office Action further alleged that the method

claimed “is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.” *Id.*

Regarding claims 37-51, the allegations in the Office Action are incorrect. The method of independent claim 37, for example, is clearly tied to a particular machine, such as “a set of machines in a network,” and “a test system comprising test facilities replicating at least one of said machines in said set.” Therefore, independent claim 37, and dependent claims 38-51, are statutory.

Regarding claim 72, and without conceding to the Office Action’s assertions, Applicants have amended claim 72 to recite a computer-readable medium encoded with a computer program product. As described in the U.S. Patent and Trademark Office’s recently issued *Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101* (Aug. 2009), “a claim to a non-transitory, tangible computer readable storage medium *per se* that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a manufacture would be patent-eligible subject matter.” *Interim Instructions* at 4.

Accordingly, Applicants request withdrawal of the 35 U.S.C. § 101 rejection.

Rejection of Claims 37-39, 46-51, 54-56, 63-68, 71, and 72 under 35 U.S.C. § 102(b):

Applicants request reconsideration and withdrawal of the rejection of claims 37-39, 46-51, 54-56, 63-68, 71, and 72 under 35 U.S.C. § 102(b) as being anticipated by Baehr. See Office Action, pp. 5-6.

In order to establish anticipation under 35 U.S.C. § 102, the Office Action must show that each and every element as set forth in the claim is found, either expressly or inherently described, in Baehr. See M.P.E.P. § 2131. Baehr, however, does not disclose each and every element of Applicants’ claims. Specifically, Baehr does not disclose or suggest at least Applicants’ claimed “in the absence of an adverse effect, allowing, by said test system, the

communication entities not having the adverse effect to communicate with said set of machines,” as recited in claim 37 (and similarly in claim 54).

Baehr discloses a “system for packet filtering of data packets at a computer network interface.” Baehr, Title. The system includes a private network, a public network, and “a proxy network that contains a predetermined number of the hosts and services, some of which may mirror a subset of those found on the private network.” Baehr, Abstract. Baehr further discloses a packet screening system 340, which may allow data packets to pass through, or may drop the data packets. *See id.* Data packets may also be sent to “a host on the proxy network that performs some or all of the functions of the intended destination host.” *Id.*

The Office Action appears to equate the “proxy network” of Baehr with the “test system” of claim 37. *See id.* This is incorrect. The “test system” of claim 37 and the “proxy network” of Baehr are distinguishable. Noting that claim 37 (and similarly, claim 54) recites that “in the absence of an adverse effect,” the claim further recites “allowing, by said test system, the communication entities not having the adverse effect to communicate with said set of machines.” In contrast, the proxy network disclosed in Baehr does not allow data packets to communicate with the private network even in the absence of adverse effects. In Baehr’s system, the proxy network functions as a mirror of the private network. Baehr, Abstract. Furthermore, the “proxy network is isolated from the private network, so it cannot be used as a jumping off point for intruders” (emphasis added). *Id.* Thus, “[b]y provid[ing] duplicate or mirrored proxy functionality of some of the services of the private network in the proxy network, and/or functionality of unique host or other services (hardware and/or software) in the proxy network, the outside user’s requests are met while invisibly preventing him/her from ever actually accessing the private network.” Baehr, col. 8, lines 40-46. Therefore, the proxy network of

Baehr does not allow the user to communicate with the private network. Instead, the proxy network communicates with the user on behalf of the private network, functioning as a proxy.

The Office Action pointed to col. 10, lines 19-34 and steps 990 and 1010 of Fig. 11 for Baehr's alleged disclosure of the features recited in claim 37. Steps 990 and 1010, however, are performed by the screening system 340, rather than the proxy network 430. *See* Baehr, col. 10, lines 1-67, and Figs. 8-11. Therefore, Baehr does not disclose, among other things, "in the absence of an adverse effect, allowing, by said test system, the communication entities not having the adverse effect to communicate with said set of machines," as recited in claim 37 (and similarly claim 54).

Since Baehr does not disclose each and every element of independent claims 37 and 54, Baehr does not anticipate Applicants' independent claims 37 and 54 under 35 U.S.C. § 102(b). Therefore, independent claims 37 and 54 should be allowable over Baehr. In addition, dependent claims 38, 39, 46-51, 55, 56, 63-68, 71, and 72 should be allowable at least by virtue of their respective dependence from base claim 37 or 54, and because they recite additional features not disclosed in Baehr. Accordingly, Applicants request withdrawal of the rejection.

Rejection of Claims 40-45, 52, 53, 57-62, 69, and 70 under 35 U.S.C. § 103(a):

Applicants request reconsideration and withdrawn of the rejection of claims 40-45, 52, 53, 57-62, 69, and 70 under 35 U.S.C. § 103(a) as being unpatentable over Baehr in view of Ramsey.

The Office Action has not properly resolved the *Graham* factual inquiries, as required to establish a framework for an objective obviousness analysis. *See* M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), as reiterated by the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In particular, the Office Action has not properly ascertained the differences between the claimed

invention and the prior art, at least because the Office Action has not interpreted the prior art and considered both the invention and the prior art as a whole. See M.P.E.P. § 2141(II)(B).

As explained above, Applicants have established that Baehr does not disclose or suggest at least Applicants' claimed "in the absence of an adverse effect, allowing, by said test system, the communication entities not having the adverse effect to communicate with said set of machines," as recited in claim 37 (and similarly in claim 54).

Ramsey does not cure the deficiencies of Baehr. For example, Ramsey discloses an "integrated computer security management system and method." Ramsey, Title. The system of Ramsey includes an "intrusion detection system (IDS)." Ramsey, Abstract. Ramsey, however, does not teach or suggest, among other things, the claimed

providing a test system comprising test facilities replicating at least one of said machines in said set . . . [and]

running said communication entities . . . on said test facilities to detect possibly adverse effects on said test system; . . . and

ii) in the absence of an adverse effect, allowing, by said test system, the communication entities not having the adverse effect to communicate with said set of machines,

as recited in claim 37 (and similarly in claim 54).

Therefore, Baehr and Ramsey, taken either alone or in combination, fail to teach or suggest at least the above-quoted recitations of Applicants' claims 37 and 54. Thus, the Office Action has not properly ascertained the differences between the cited references and the claimed invention. Independent claims 37 and 54 should therefore be allowable over Baehr and Ramsey. Therefore, dependent claims 40-45, 52, 53, 57-62, 69, and 70 should be allowable at least by virtue of their respective dependence from base claim 37 or 54, and because they recite additional features not taught or suggested in Baehr and Ramsey. Accordingly, Applicants respectfully request withdrawal of the rejection.

Conclusion

Applicants request reconsideration of the application and withdrawal of the rejections. Pending claims 37-72 are in condition for allowance, and Applicants request a favorable action.

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are identified herein, Applicants decline to automatically subscribe to any such statements or characterizations.

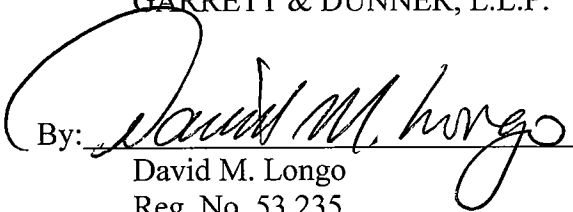
If there are any remaining issues or misunderstandings, Applicants request the Examiner telephone the undersigned representative to discuss them.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 27, 2010

By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (571) 203-2763/